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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,422	03/22/2001	Satoru Suzuki	09812.0161-00000	4553
22852	7590	04/05/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/815,422	<b>Applicant(s)</b> SATORU ET AL	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 8-29 and 34-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 30-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-43 are pending. Claims 8-29 and 34-43 have been withdrawn and Group I, claims 1-7 and 30-33 have been elected without traverse for examination in the communication filed 1/11/06 entered as Response to Election/Restriction.
2. The Correspondence Change in Address and Change in Power of Attorney filed 09/06/05 has been entered.
3. The Miscellaneous Letter filed 10/28/05 has been entered.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-7 and 30-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims begin with the word "An apparatus" which is unclear and indefinite what Applicants' mean by an "apparatus".

The claims recite "designing a plurality of functions". This phrase lacks antecedent basis. As well, one of ordinary skill in the art of a generic apparatus would be hard put to identify "designing a plurality of functions". Such a function is broad, varied and constantly changing. The plurality of functions could be any functions on any apparatus.

The claims recite "chargeable amount ...". There is no positive recitation as to the "chargeable amount" in the recited step it is not considered limiting. It is unclear

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how the amount is charged and what the amount is charged on. Applicants' title of the invention recites "Electronic Apparatus, Charging System and Method, Charge Processing Device, Storage Medium and Prepaid card". The claim limitations do not recite or mention anything about a "prepaid card".

Examination has been done to the best of the Examiner's ability given the condition of the claims. The claims appear to be a literal translation from a foreign document rendering the claims vague and indefinite.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-7 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,198,915) McGregor et al, hereafter McGregor.

Claim 1. McGregor discloses An apparatus comprising: operation inputting means for designating one of a plurality of functions (col. 3, lines 42-51); function executing means for executing the function designated by said operating inputting means (col. 4, line 46-col. 5, line 5); measuring means for measuring the time during which each of said functions has been executed by said function executing means (col. 16, line 38-col. 17, line 5 and lines 31-38); and chargeable amount computing means for computing a chargeable amount based on the execution time measured by said measuring means regarding each of said functions (col. 12, lines 44-52).

In treatment of the last limitation quoted above regarding a chargeable amount computing means computes said chargeable amount based on the execution time regarding each of said functions and through weighting on a function-by-function basis, it is understood that McGregor discloses a mobile phone with an internal account charging program which can compute a chargeable amount based on the time used for each function. Further the last limitation is broadly and reasonably interpreted as McGregor disclosing this limitation.

Claim 2. McGregor discloses An apparatus according to claim 1, wherein said chargeable amount computing means computes said chargeable amount based on the execution time regarding each of said functions and through weighting on a function-by-function basis (col. 18, lines 11-57).

Claim 3. McGregor discloses An apparatus according to claim 2, wherein said function executing means is controlled by a microprocessor, and wherein said chargeable amount computing means computes said chargeable amount based on the execution time regarding each of said functions and through weighting by a load factor of said microprocessor in effect during execution of each of said functions (col. 3, line 42-col. 4, line 9 and col. 18, lines 30-57).

Claim 4. McGregor discloses An apparatus according to claim 2, wherein said chargeable amount computing means computes said chargeable time based on different weighting factors set for different apparatuses (col. 14, line 29-col. 15, line 42).

Claim 5. McGregor discloses An apparatus according to claim further comprising: storing means for storing an accumulated execution time representing a total of execution times measured by said measuring means (col. 5, lines 24-44); and transmitting means for transmitting said accumulated execution time from said storing means to an external entity for settlement of charges (col. 14, lines 29-49).

Claim 6. McGregor discloses An apparatus according to claim 1, further comprising: storing means for storing a chargeable time representing the chargeable amount computed by said chargeable amount computing means (col. 5, lines 24-44 and line 61-col. 6, line 8); and transmitting means for transmitting said chargeable time from said

storing means to an external entity for settlement of charges (col. 3, line 52-col. 4, line 4 and lines 23-32 and col. 17, lines 31-38).

Claim 7. McGregor discloses An apparatus according to claim 1, further comprising: storing means for storing a usable time of said apparatus (col. 5, lines 29-33 and line 61-col. 6, line 8); and settling means for subtracting a chargeable time representing the chargeable amount computed by said chargeable amount computing means, stored in said storing means, from said usable time stored in said storing means (col. 13, lines 41-48).

Claim 30. This independent claim is rejected for the similar rationale as given above for claims 1 and 6.

Claim 31. This dependent claim is rejected for the similar rationale as given above for claims 5 and 6.

Claim 32. This dependent claim is rejected for the similar rationale as given above for claims 1-3.

Claim 33. This dependent claim is rejected for the similar rationale as given above for claim 6.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Caldwell et al (US 6,418,202) disclosed a prepaid calling card.

Vu (US 6,021,189) disclosed the usage of phone debt cards.

Tsumura (US 6,018,726) disclosed billing information services in conjunction with utilities services.

Usui (US 5,956,697) disclosed a time based fee charging system.

### **Inquiries**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E. Colbert  
Primary Examiner  
April 1, 2006

  
ELLA COLBERT  
PRIMARY EXAMINER